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EXAMINER

EASHOO, MARK

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,551

Applicant(s)

JUD, WILFRIED

Examiner

Mark Eashoo, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-17 is/are rejected.
- 7) ☒ Claim(s) 12-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 12-17 are objected to because of the following informalities:

Specifically, claim 12 recites a plurality of process steps without being separated by a line indentation which renders the claim indefinite because it cannot be clearly ascertained when one step ends and another begins. It is noted that where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. See 37 CFR 1.75(i).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, claim 12 recites a plurality of process steps without being separated by a line indentation which renders the claim indefinite because it cannot be clearly ascertained when one step ends and another begins. It is noted that where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. See 37 CFR 1.75(i).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zuser et al. (WO 98/26931) in view of Hill (US Pat. 3,959,546). It is noted that the column and line listings for Zuser et al. are from the English translation of the document US Pat. 6,200,663).

Regarding claim 12: Zuser et al. teaches the basic claimed process of making a lid having a roughened sealing layer, comprising: coating a substrate material with a layer to form a sealing layer (1:10-22 and 2:60-65); and embossing a coating/sealing layer between rolls to form a roughened sealing layer (3:19-30 and Fig. 3).

Zuser et al. does not teach forming an embossed /roughened sealing layer using a textured cooling roll and a smooth pressure/backing roll. However, it is noted that Zuser et al. a shaped/textured pressure roll is used to form depressions on the sealing layer (3:19-30) but is silent with regard to how the coating is initially applied to the film or how a backing pressure is applied to the side opposite of the sealing layer. Nonetheless, Hill teaches embossing an extrusion coating using an extruder, a textured cooling roll, and a pressure/backing roll (1:64-2:20 and Fig. 1). Essentially, Hill suggests that a single station may be used to extrude, cool, emboss, and unit a substrate with a coating layer. Zuser et al. and Hill are combinable because they concerned with a similar technical difficulty, namely, forming a texture upon a coated layer in a continuous process. At the time of invention a person having ordinary skill in the art would have found it obvious to have embossed an extrusion coating using a textured cooling roll and a pressure/backing roll, as taught by Hill, in the process of Zuser et al., and would have been motivated to do so in order to gain an economic benefit of a single process unit to both coat and emboss a film substrate.

It is noted that Zuser et al. provides a smooth print layer (Fig. 3, element 2) opposite the embossed sealing layer. It is submitted that it is well within the skill of an ordinary artisan to have used a smooth pressure/backing roll since Zuser et al. clearly teaches away from damaging the print layer (1:38-45). Furthermore, it is inherent that the textured cooling roll contacting the sealing layer of Zuser et al. does not penetrate through the sealing layer as evidenced by Figure 3.

Regarding claims 13-16: Zuser et al. teaches a coating roughness of 1-100 μm (1:50-64).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zuser et al. (WO 98/26931) in view of Hill (US Pat. 3,959,546) as applied to claims 12-16 above, and further in view of Beer et al. (EP 0 514 803 A1).

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Zuser et al. does not teach a polyethylene sealing layer. Nonetheless, Beer et al. teaches an extruded or coextruded polyolefin sealing layer (2:45-52 and Fig. 1, element 8). It is noted that the term polyolefin is commonly known in the molding art to mean polyethylene, polypropylene, or the like. Zuser et al. and Beer et al. are combinable because they from the same field of endeavor, namely, packing foils/lids. At the time of invention a person having ordinary skill in the art would have found it obvious to have used polyethylene, as taught by Beer et al., in the process of Zuser et al., and would have been motivated to do so in order to gain an economic benefit of using a low cost material.

Response to Arguments

Applicant's arguments filed 04-NOV-2003 have been fully considered but they are not persuasive. Applicant's arguments have been substantially responded to in the above rejection. However, the following comments apply:

1.) Applicant remarks regarding that the Examiner suggested that Zuser et al. uses a two-step process is incorrect. Rather, the Examiner only stated that a coating is applied and a sealing layer is embossed. To clarify this, the Examiner has noted in the above rejection that Zuser et al. is silent with regard to how the coating is initially supplied. Applicant arguments incorrectly assumed Zuser et al. "uses a pressure roll to apply a sealing layer", rather Zuser et al. broadly teaches that coating having spacers/depression is produced "with the aid" of a shaped roller. Hill is combined with Zuser et al. to show how the coating can be initially applied to the film including forming a texture in the coating with the "aid" of a textured cooling roll.

2.) Applicant's suggest that it is mere speculation to apply a backing force to Zuser et al. ignores the fact the obviousness rejection is based upon a combination of references wherein the secondary reference provides teaching of a backing roller, if not inherent in Zuser et al. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

3.) Applicant alleges that Zuser et al. does not teach a cold embossing roll. Once again, applicant has ignored the teaches of Hill and has merely attacked the reference individually where the rejection is clearly based upon a combination of references.

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4.) Applicant argument also appear to allege that the combination somehow destroys Zuser et al. However, Applicant has again overlooked the teachings of Hill which uses a soft backing roll (element 15) and clearly teaches the "surface forms a replica of the chill roll" which would tend to suggest to a person having ordinary skill in the art that the embossing does not transfer through the film. Not to mention, Applicant also appears to have overlooked that the Zuser et al. (Fig. 3) suggests an operating pressure, by what ever means used, should not cause an embossment on the print layer or the side opposite the sealing layer.

5.) Applicant alleges the Hill does not teach a backing roll which does not form a nip with the cold textured roll. This allegation presumes stupidity upon a person having ordinary skill in the art that such skilled artisan would be unable to comprehend that because Hill teaches a "backing roll" and a "rubber roll" that the "rubber roll" would not apply pressure to the nip against the textured roll. It is maintained that a person having ordinary skill in the art would recognize any roll forming a nip with a textured roll as a roll which applies backing pressure for the embossing process.

6.) Applicant argues that the rejection does not provide a motivation statement because the rejection stated that "Hill and Zuser et al. are combinable because...". This is not found persuasive because Applicant has apparently ignored the phrase in last sentence of the second paragraph containing the word "motivated". Furthermore, it is noted that for references to be properly combined the references must be Analogous Art (see MPEP § 2141.01(a)). The rejection addresses this important criteria by stating that the references are both "concerned with a similar technical difficulty...".

It is further noted that it is well established that "economic benefit" is grounds for proper motivation and that motivation does not have to be present in the applied references themselves, but may common from common knowledge generally available in the art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until

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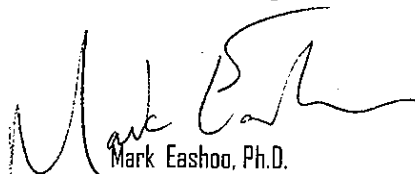
after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Eashoo, Ph.D. whose telephone number is (571) 272-1197. The examiner can normally be reached on 7am-3pm EST, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaiani can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Mark Eashoo, Ph.D.
Primary Examiner
Art Unit 1732

13/Jan/04

me
January 13, 2004